

PATENT APPLICATION
Attorney Docket No. IMS 05-03

CERTIFICATE OF ELECTRONIC FILING SYSTEM TRANSMISSION
AS REQUIRED BY 37 C.F.R. 1.8(a)(1)(ii)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Kembel et al.)	Confirm. No.: 1665
)	
Appl. No.: 09/558,922)	TC/A.U.: 2176
)	
Filed: 04/26/2000)	Examiner: C.T. Nguyen

Title: Apparatus and Method of Hosting Internet Content

VIA EFS-Web
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04/02/2009

RESPONSE TO FINAL OFFICE ACTION PURSUANT TO 37 C.F.R. 1.116

Sir:

In response to the final Office Action mailed on February 5, 2009, (the "Final Office Action") in the above-identified application, applicant submits the following response. This response is being filed before the expiration of two-months from the date of mailing of the Final Office Action. Applicant asserts that no fees are due with this filing. The Examiner's review and reconsideration of this application and its claims in light of the following amendments and remarks is respectfully requested.

AMENDMENTS TO THE CLAIMS AND CLAIM LISTING

The listing of the claims immediately below, in which certain amendments are highlighted, replaces all prior versions of the claims provided in this application. Amendments to the claims previously entered in this application have not been highlighted herein.

32. (Cancelled herein)

33. (Previously cancelled)

34. (Previously cancelled)

35. (Cancelled herein)

36. (Cancelled herein)

37. (Cancelled herein)

38. (Cancelled herein)

39. (Amended herein) A computer-usable memory device on which is stored instructions, said instructions implementing a method of providing Internet content to a user of a computing device, comprising:

receiving a request from a computing device;

in response to the request, retrieving data ~~that is programmed in a format readable by a Web browser program, the data~~ comprising;

instructions ~~for~~ programmed in a format readable by a Web browser program,
said instructions:

invoking a computing device resident process ~~and~~ for obtaining
content data, in a format readable by a Web browser program, from a
device other than the client device; and

~~to be displayed~~ displaying said content, at the computing device,
independently outside of a window of a Web browser program in response
to execution of said computing device resident process; ~~and~~

a definition that defines ~~at least in part~~ a functionality and an appearance of a
user interface outside of a window of a Web browser program and which includes a
frame within which the results of the computing device resident process are
presented in response to execution of said computing device resident process; and

transmitting the data to the computing device.

40. (Cancelled herein)

41. (Cancelled herein)

42. (Amended herein) The ~~method~~ computer-usable memory device of claim 39, wherein
the definition is provided by a Web content provider, thereby enabling the Web content provider
to control at least in part a functionality and an appearance of the user interface when rendered
on the computing device.

43. (Amended herein) The ~~method~~ computer-usable memory device of claim 42, wherein
the computing device resident process, content data, and the definition are provided by the Web

content provider, thereby enabling the user interface to integrate seamlessly with the results of the computing device resident process and content data.

Claims 44-57. (Previously cancelled).

REMARKS

Claims 39, 42, and 43 are pending in the present application, and accordingly only those claims are discussed in the detailed response, below. Claim 39 has been amended. Claims 32-35 and 40-41 have been cancelled. Applicant appreciates the Examiner's continued careful consideration of this application. The remarks below support applicant's assertion that the pending claims distinguish over the cited prior art, and are in condition for allowance.

(A) Propriety of the present claim amendments under 37 CFR 1.116

37 CFR 1.116 provides for certain circumstances under which amendments to claims after final rejection are permissible. Applicant acknowledges that entry of amendments in these circumstances is not a matter of right, but within the discretion of the Examiner. The first of those circumstances is when the claim amendments are supported by a showing of good and sufficient reasons why they are necessary and were not earlier presented (37 CFR 1.116(b)(3)). Applicant asserts that the amendments made herein are necessary in order to better clarify and support the points that applicant makes distinguishing the cited references. These have been previously made, however it appears from the text of the Final Office Action that those points may not have been made sufficiently clear in applicant's previous response. Therefore, in order to further highlight and clarify these points, the claims have been amended herein. Specifically, all claim limitations but for those of claims 42 and 43 have been combined into a single independent claim 39. Applicant respectfully asserts that there are no substantive amendments other than the incorporation of limitations from other claims made to claim 39. Finally, these amendments were not earlier made because the lack of clarity regarding the points made in this

response was brought to light in the Final Office Action, the most recent correspondence from the Examiner. Ideally, these amendments place the application in condition for allowance. Therefore, upon the showing made hereinabove, applicant requests that the Examiner enter the amendments to the claims presented in this response.

The second circumstance under which amendments to claims after final rejection are permissible is that the amendments present the rejected claims in better form for consideration on appeal (37 CFR 1.116(b)(2)). Applicant respectfully states that if the next action in this application in response hereto is not an indication of allowability, an appeal of the claims as amended may be warranted. Again, it appears that certain of the points applicant has made previously to distinguish the cited references were not sufficiently clear. The amendments made herein are an effort where in the claims the points are based. It is hoped that if an appeal is necessary, the amendments will make the work of the examiner and the appeals board (as well as applicant) easier by reducing the number of claims to be considered and clarifying the limitations in those appealed claims. Accordingly, applicant respectfully requests that the Examiner enter the amendments to the claims presented herein so as to present those claims, if necessary, in better form for consideration on appeal.

(B) 35 U.S.C. § 103(a)

Turning now to the substance of the Final Office Action, claims 39 and 42-43 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Barnett (USP 6,369,840) in view of Dang (USP Pub. 2002/0089536). While applicant has amended the

claims presented in this application such that they are more focused on an aspect of the invention, applicant respectfully traverses the rejection on the following grounds.

(1) The combination of Barnett and Dang fail to teach a method which provides content, readable by a Web browser program, for rendering a user interface independent of a web browser program

As mentioned in applicant's previous reply, the entirety of Barnett teaches a system and method which employs a web browser to manage interactions with a server and the retrieval, rendering, and interaction with content on a user's computer. In only one brief reference (col. 7, lines 29-30) does Barnett suggest that an embodiment other than one dependent on a browser is contemplated. Barnett is utterly devoid of how one might create a system and process that operates independent of and without employing a web browser program. But perhaps more fundamentally, Barnett fails to teach or suggest a method for retrieving and providing data, including instructions programmed in a format readable by a Web browser program for invoking a computing device resident process which retrieves content data, and a definition of a user interface rendered independently of and outside a window of a Web browser program within which the results of the computing device resident process are presented.

Dang discloses that applications can be written in the Java programming language that operate independent of a web browser application. Since Java is a language that may be interpreted by a web browser program having a Java Virtual Machine (JVM) present, it is asserted that Dang stands for the proposition that code, interpretably by certain web browser programs, may be operable independent of a web browser program. However, with regard to

the pending claims, Dang also lacks a teaching or suggestion of a method for retrieving and providing data, including instructions programmed in a format readable by a Web browser program for invoking a computing device resident process which retrieves content data, and a definition of a user interface rendered independently of and outside a window of a Web browser program within which the results of the computing device resident process are presented.

It is agreed that the combination of Barnett and Dang could suggest to one skilled in the art a system that provides Barnett's web-based content on a user's computer in a Java program according to Dang (i.e., outside of a Web browser window and independent of a Web browser program). However, that alone is not sufficient to support a rejection of obviousness of the pending claims. Rather, the combination of references must show every element of the rejected claims or provide sufficient details that, when taken together with their knowledge, one of ordinary skill in the art would be led to the claimed invention. What is missing from this combination is a teaching of data including instructions for invoking a computing device resident process for obtaining content, in a format readable by a Web browser program, from a device other than the client device (claim 39, lines 6-9, as amended).

As previously discussed, since the data referred to in the cited sections of Barnett is stored in the information database (112), one skilled in the art would interpret that that data would be of a type typically stored in databases, such as raw data in a delimited (tab, comma, etc.) format, readable by an interface to that database, and not data programmed in a format readable by a Web browser program. This reference to an information database thus teaches away from the providing the data in a format readable by a Web browser program. Dang is silent as to the concept of retrieving content from a device other than the client device. Thus, the combination of Barnett and Dang fails to suggest this claim limitation.

Furthermore, the combination of references, together with the knowledge of one of ordinary skill in the art, must provide some suggestions as to how one skilled in the art might obtain the specific claimed system or method (i.e., one which provides for retrieving and providing data, including instructions programmed in a format readable by a Web browser program for invoking a computing device resident process, content data, and a definition of functionality and an appearance of a user interface outside of a window of a Web browser program within which the results of the computing device resident process are presented). See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) ("Prior art references discussing the production of monoclonal antibodies may constitute "invitations to try monoclonal antibodies in immunoassays" but do not show obviousness since they "do not suggest how that end might be accomplished," 802 F.2d at 1383, 231 USPQ at 93). However, not only is the combination of Barnett and Dang lacking any suggestion of at least one element of the rejected claims (obtaining content, in a format readable by a Web browser program, from a device other than the client device) it is lacking any teaching as to how one might go about even producing a system or method for retrieving web content and displaying that content independent of a web browser program and outside of a window of a web browser.

Accordingly, applicant reasserts that the combination of Barnett and Dang is not sufficient to support a prima facie case of obviousness of the pending claims under 35 U.S.C. 103(a). Removal of the final rejection, and reconsideration and allowance of those claims is respectfully requested.

(2) Barnett and Dang each fail to teach receiving instructions for invoking a client-resident process for obtaining data

It is also noted that the pending claims include the limitations "instructions, programmed is a format readable by a Web browser program, for invoking a computing device resident process for obtaining content data." (Claim 39, lines 6-9, as amended.) The Final Office Action fails to point to a specific instance in either reference where such a limitation is taught. Barnett teaches a fairly traditional client-server model in which processing is performed on the server and data is delivered therefrom for display on the client. The Final Office Action suggests that this limitation is taught at Figs. 5-6, col. 5, lines 3-35, col. 6, lines 4-25, and col. 9, lines 2-15. The cited sections do not, however, teach this limitation. Rather, Figs. 5-6 are simply screen shots of the application taught by the reference. Column 5, lines 3-35 discuss load balancing on the server taught by the reference. Column 6, lines 4-25 discuss the operation of processes on a server, and the sources of data for those processes on the server. All elements referred to in this cited section are resident on a server, as can be inferred from the distinctions drawn between Figs. 1A-1B (server) and Fig. 2 (client). Finally, column 9, lines 2-15 describes a login process in which certain user data is retrieved from server memory, and a personalized welcome greeting is generated and displayed. The greeting is generated on the server, and delivered to the client for display. Importantly, nothing in these sections describes or suggests delivery of "instructions ... for invoking a computing device resident process."

Similarly, nothing in Dang suggests that in response to a request from a computing device, data be retrieved which include instructions for invoking a computing device resident process for obtaining content data from a device other than the client device to be displayed at

the computing device outside of a window of a Web browser program in response to execution of said computing device resident process.

Accordingly, the combination of the Barnett and Dang references cannot teach or suggest each and every claim limitation in the pending claims. For this additional reason, applicant request reconsideration and removal of the finality of the rejection, and reconsideration and allowance of the pending claims.

(C) Request for Post-Final Interview

Applicant requests that, if the above is not sufficient in the Examiner's opinion to place this application in condition for allowance, that the Examiner grant an interview with the undersigned to discuss the merits of the claims, the rejections, and options for proceeding on behalf of the client. This request is made pursuant to MPEP 7.14.12. Applicant asserts that circumstances warrant such an interview as the paper record in this case is long, and claims of varying scope have been considered, and yet applicant and the Office do not appear to be converging on allowable subject matter.

Conclusion

For the foregoing reasons, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested. Alternatively, if the Examiner disagrees that the above amendments and arguments

put the case in condition for allowance, applicant requests that the Examiner enter the amendments so that the claims are in condition for appeal.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

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